

(B) There must be a serious burden on the examiner if restriction is required.

In the present case, Applicants respectfully submit that the Examiner is incorrect that an undue search burden is imposed if the claims of Groups II and III are included with those of elected Group I. In particular, the Examiner is incorrect that each of the foregoing groups "would require completely different searches." Paper No. 7, page 3.

Independent claim 30 refers to a fluorescent particle comprising two compounds selected from specified groups. Because the claim is written in open form, the fluorescent particle of claim 30 does not exclude additional unspecified components. MPEP § 2111.03. Claims 43 and 44, which the Examiner seeks to restrict from Group I, depend from claim 30, and simply recite a fluorescent particle that includes such an additional component (an antibody or a nucleic acid).

Claim 30 is thus a linking claim which, if allowable, must result in withdrawal of a restriction requirement as to the linked inventions. MPEP § 809.03. Moreover, because claims 43 and 44 are species within the scope of generic claim 30, any complete search of Group I must include a search for Groups II and III as well. Conversely, any search of Group I that would not include the subject matter of Groups II and III would not be a "thorough search of the art." MPEP § 904.02.

Because the search for Group I necessarily includes a search for Groups II and III, Applicants respectfully submit no undue search burden is imposed if the claims of Groups II and III are included with those of elected Group I. Applicants, therefore, request that the Examiner withdraw the restriction requirement and examine all currently pending claims on the merits.

The Examiner has also requested election of a single species for prosecution if no generic claim is deemed allowable. Applicants elect the particle of claim 42. Specific support for such a particle can be found, *e.g.*, in particle 107 of Table 1. Claim 42 clearly recites the specific structure of the first and second compound included in the fluorescent particle, which may be simply incorporated in a particle by noncovalent means. *See, e.g.*, Example 67. Should this be an insufficient recitation of the elected species, Applicants respectfully request clarification of the Examiner's request that "all of the atoms and bonds... including all points of attachment [be shown]" (Paper No. 7, page 4), as it is unclear what other atoms and bonds the Examiner is referring to.

The Examiner also requests that a single particle matrix be elected; that a particle size be elected; and that those claims reading on the elected particle be indicated. Applicants hereby elect latex particles as recited in claim 31, and the size recited in claim 46. Claims 30, 31, 42, 45, and 46 read upon the elected particle, either generically or specifically.

Applicants note that, should generic claim 30 be allowable, all claims drawn to nonelected species that are within the scope of the allowable generic claim should be allowed. MPEP §§ 809.02(c) and (e).

In view of the foregoing remarks, Applicants respectfully submit that the pending claims are in condition for allowance. An early notice to that effect is earnestly solicited. Should any matters remain outstanding, the Examiner is encouraged to contact the undersigned at the address and telephone number listed below so that they may be resolved without the need for additional action and response thereto.

Respectfully submitted,
FOLEY & LARDNER

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